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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,790	12/24/2003	Masanao Yamagishi	2003_1869A	9812

513 7590 10/30/2006

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,790

Applicant(s)

YAMAGISHI ET AL.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 September 2006 has been entered. Claims 8, 9, and 12-15 are pending in the application. Claims 1-7, 10, and 11 have been canceled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 9, and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "said fall-off prevention pawl" in the last indentation of the claim (newly added portion). There is insufficient antecedent basis for this limitation in the claim. The fall-off prevention pawl is set forth in claim 9. In order to

examine the claims on their merits, the limitations of claim 9 are presumed to be included in independent claim 8.

Claims 9 and 12-15 are dependent on claim 8 and are rejected for the above reason.

Claim Rejections - 35 USC § 103

4. Claims 8, 9, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser et al (US 5,788,068; supplied by applicant; hereinafter Fraser) in view of Marsilio et al (US 2002/0170838 A1; previously provided; hereinafter Marsilio) and Flores, Jr. et al (US 2003/0015443 A1; previously provided; hereinafter Flores).

Claims 8 and 9: Claim 8 is presumed to include the limitations of claim 9. Fraser discloses a cover case (see Figure 1) comprising a main body **11/12/13** having a base surface **12**, a receiving table **16**, and outer peripheral edge **12A**; a cover **11**; a support surface **19**; a pair of slit grooves (openings on either side of **15**) defining deflectable arms **15** arranged as claimed; engagement protuberances **20** arranged as claimed; and flexible resin **21**.

Fraser lacks the engagement pawls formed from cut-off portions of the engagement protuberances and generally L-shaped in cross-section, and the outer peripheral edge having a cut-off portion and fall-off prevention pawl with a support plate formed on the connecting portion striking the fall-off prevention pawl.

Marsilio teaches engagement pawls **100** formed from cut-off portions of an engagement protuberance **60** and generally L-shaped in cross-section (upwardly

extending portion **106**, radially-extending portion **110**) to reduce bending forces experienced by the disk (see for example paragraph [0042]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the engagement protuberances of Fraser with engagement pawls as taught by Marsilio in order to reduce bending forces experienced by the disk.

Fraser-Marsilio discloses the claimed invention except for the outer peripheral edge having a cut-off portion and fall-off prevention pawl with a support plate formed on the connecting portion striking the fall-off prevention pawl.

Flores discloses a cut-off portion **132**, fall-off prevention pawl **140**, and support plate **112/148** on a connecting portion **106** that strikes the back of fall-off prevention pawl **140** and is used to secure the disk in the storage area (see paragraphs [0054] and [0057] and Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Fraser-Marsilio with a cut-off portion, fall-off prevention pawl, and support plate as taught by Flores in order to secure the disk in the storage area.

Claim 12: Fraser discloses the gap (portion containing flexible resin **21**) at the center of engagement member **20**.

Claim 13: Fraser discloses the receiving table **16** at the surface **12** of main body **11/12/13**.

Claims 14 and 15: Fraser discloses at least one notch (gaps between portions **12A**) formed in the outer peripheral edge **12A**.

Response to Arguments

5. Applicant's arguments filed 14 September 2006 have been fully considered but they are not persuasive.

6. Applicant argues that none of the prior art references disclose a support plate striking the back of a fall-off prevention pawl as claimed by the applicant, this is not found persuasive since Flores clearly discloses such a support plate (112/148) that functions as claimed (see paragraph [0057]).

7. In response to the applicant's arguments that there would be no motivation to modify the Fraser reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the prior art references (see Marsilio paragraph [0042] and Flores paragraph [0057]). The motivation for modifying a primary reference need not come from the primary reference itself, but may come from a secondary reference. *In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Greg Pickett
Examiner
28 October 2006